



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,335	09/08/2003	Seth Haberman	20429/25	1662
28/089 7590 06/24/2009 WILMERHALE/NEW YORK 399 PARK AVENUE NEW YORK, NY 10022				
EXAMINER LANGHOVA, KUNAL N				
ART UNIT 2427		PAPER NUMBER		
NOTIFICATION DATE 06/24/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com

teresa.carvalho@wilmerhale.com

sharon.mathews@wilmerhale.com

### Office Action Summary

**Application No.**

10/657,335

**Applicant(s)**

HABERMAN ET AL.

**Examiner**

KUNAL LANGHNOJA

**Art Unit**

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/16/2009 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-13 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hite et al (United States Patent 5,774,170).

Regarding claim 1, Hite teaches "a method for creating a message campaign, said message campaign allowing the creation of a plurality of different individual

advertisements for targeted audiences, based upon criteria of said targeted audiences,"(Figure 1; Abstract, Col.4 lines 3-11, Col.10 lines 54-67) comprising:

"providing a plurality of media segments (i.e. multiple commercials), said media segments configured to be assembled into said plurality of individual advertisements, wherein at least one of said media segments is interchangeable with another one of said media segments. (i.e. based on CID codes, different commercials is/are displayed at different sites)" (Figure 1; Col.4 lines 3-11);

"providing assembly information (i.e. CID code) regarding how said plurality of media segments (i.e. commercials) may be assembled to create said plurality of individual advertisements (i.e. targeted commercials);" (Col.4 lines 3-11, Col.5 lines 40-50) and

"associating said assembly information (i.e. CID codes) with said plurality of media segments (i.e. commercials)."(Col.5 lines 58-62)

Regarding claim 2, Hite et al teaches "an individual advertisement for a specific targeted audience is assembled at a later time (i.e. targeted commercial is displayed based on the CID code saved at the receiver), said individual advertisement message being assembled based upon said assembly information (i.e. each commercial includes CID code), said plurality of media segments, and on information regarding said target audience. (Col.4 lines 3-11, Col.5 lines 40-50, 58-62 and Col.10 lines 54-67)

Claim 3 is rejected wherein "at least one media segment used to assemble one of said individual advertisements is created at said later time." (Col.5 lines 40-50, 58-62 and Col.6 lines 10-13)

Claim 4 is rejected wherein "assembly information(i.e. CID codes) includes rules for use at said later time, said rules for use in determining which of said plurality of said media segments (i.e. commercial) to use in assembling an individual advertisement (i.e. targeted commercial) for said specific targeted audience, based on said information regarding said target audience." (Col.4 lines 3-11, Col.5 lines 40-50, 58-62, Col.6 lines 10-13, Col.10 lines 54-67)

Claim 5 is rejected wherein "rules include default conditions for determining which of said plurality of said media segments to use when no appropriate information regarding said target audience is available."(Col.4 lines 12-18, Col.6 lines 3-6)

Claim 6 is rejected wherein "media segments include audio, video, voice overs, and background music."(Col.10 lines 11-16)

Claim 7 is rejected wherein "a subset of said plurality of media segments form a default generic individual advertisement." (Col.4 lines 12-18, Col.6 lines 3-6)

Claim 8 is rejected wherein "said assembly information includes data representing time segments; said media segments, and conditions."(Col.4 lines 3-18 and Col.5 lines 58-62)

Claim 9 is rejected wherein "said individual advertisement for a specific targeted audience is assembled in a set top box for a television receiver contemporaneously with displaying said individual advertisement to said specific targeted audience (i.e. a sequence of commercial are generated)." (Col.4 lines 45-51 and Col.5 lines 40-50)

Claim 10 is rejected wherein "the plurality of media segments includes alternative segments of different lengths."(Col.5 lines 58-62)

Claim 11 is rejected wherein "the assembly information contains a role for choosing each of the media segments." (Col.4 lines 34-40)

Claim 12 is rejected wherein "the rule for choosing a media segment depends on the outcome of a previous choice." (Col.4 lines 52-61)

Claim 13 is rejected wherein "the assembly information contains a rule disallowing a combination of media segments." (Col.4 lines 34-44)

Claim 19 is rejected wherein "the media segments include video segments and other media segments." (Col.5 lines 40-50)

Claim 20 is rejected wherein "the other media segments include audio segments." (Col.5 lines 40-50)

Claim 21 is rejected wherein "the assembly information includes roles for the assembly of the video segments and rules for the assembly of the other media segments." (Col.4 lines 3-11, lines 45-51, Col.5 lines 40-62)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al, in view of Khusheim et al (United States Patent Application Publication 2003/0221191).

Regarding claim 14, Hite et al teaches everything claimed (see claim 1). However, the reference is unclear with respect to "each media segment is associated with a segment parameter, the assembly data including a rule basing a choice of a media segment on its associate segment parameter."

In similar field of endeavor, Khusheim teaches " each media segment (i.e. commercial) is associated with a segment parameter (i.e. criteria), the assembly data including a rule basing a choice of a media segment (i.e. commercial) on its associate segment parameter (i.e. criteria)."(Paragraphs 0040, 0042, 0046, 0104) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite for the common knowledge purpose of providing target commercials based on user's criteria.

Regarding claim 15, Hite and Khusheim, the combination teaches everything claimed (see claim 15). The combination teaches "the segment parameters identify a demographic of an intended audience."(Khusheim: Paragraph 0011, 0046)

Claim 16 is rejected wherein "the segment parameters identify an environmental condition."(Khusheim: Paragraphs 0045 and 0046)

Claim 17 is rejected wherein "a media segment is associated with a plurality of different segment parameters."(Khusheim: Paragraph 0011, and 0046)

Claim 18 is rejected wherein "the different segment parameters are assigned priorities, the assembly data including a rule basing a choice of a media segment on the different segment parameters according to the assigned priorities."(Khusheim: Paragraphs 0011, 0045 and 0046)

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KUNAL LANGHNOJA whose telephone number is 571-270-3583. The examiner can normally be reached on M-F 10:00 A.M.- 6:00 P.M. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on 571-272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. L./  
Examiner, Art Unit 2427

/Scott Beliveau/  
Supervisory Patent Examiner, Art Unit 2427